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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,535	01/16/2002	Siegbert Vial	3241-72	4319
8933	7590	12/08/2003	EXAMINER	
DUANE MORRIS, LLP ATTN: WILLIAM H. MURRAY ONE LIBERTY PLACE 1650 MARKET STREET PHILADELPHIA, PA 19103-7396			PRUNNER, KATHLEEN J	
			ART UNIT	PAPER NUMBER
			3751	
DATE MAILED: 12/08/2003				15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	VIAL, SIEGBERT
Examiner	Art Unit
Kathleen J. Prunner	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2003 and 30 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5, 8, 10-13 and 16-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 22 and 30 is/are allowed.
- 6) Claim(s) 1-5, 8, 10-13, 16-21, 23-29 and 31-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14. 6) Other: _____.

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DETAILED ACTION

Drawings

1. The proposed drawing correction, filed on September 8, 2003 (Paper No. 13), has been approved by the Examiner.
2. The substitute sheets of formal drawings, filed on September 8, 2003 (Paper No. 13), have been disapproved by the Draftsman as noted on the attached Form PTO-948. Corrected formal drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) **not mentioned** in the description: **(A) 50b** (note Figs. 1a, 1b, 1c and 5, illustration "B"); **(B) 41a** (note Figs. 7a and 7b); and **(C) 26** (note Figs. 7a and 7c). A proposed drawing correction or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "41" and "42" have both been used to designate the same channel portion (note Figs. 2a, 2b, 7a, 7b, 7c, 7d, 8a and 8b). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "y₁" and "27" have both been used to designate a distance (note Fig. 8b). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “34” has been used to designate both an inner part (note Fig. 7a and lines 8-9 on page 20) and a shoulder (note line 19 on page 20). A proposed drawing correction or amendment to the specification to correct the description is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. Applicant is required to submit a proposed drawing correction in response to this Office action. Any proposal by applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office action, and may not be deferred.

Specification

8. The substitute specification, filed September 8, 2003 (as part of the amendment, Paper No. 12), has been entered. However, the pages of the substitute specification are not numbered consecutively, starting with 1, as required by 37 CFR 1.52(b). Therefore, the Examiner has renumbered the pages of the substitute specification from 1 to 21 with page 10 being numbered as page 1 and page 30 being numbered as page 21.

9. The following informalities in the specification are noted: (A) on page 19, line 15, “34” should read --35--. Appropriate correction is required.

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10. The following informalities in the claims are noted: (A) in claims 1, 28, 30, 31 and 34, in line 1, "Writing instrument" should read --A writing instrument--; (B) in claims 2-5, 8, 10-13, 16-27, 29, 32, 33 and 35, on line 1, "Writing instrument" should read --The writing instrument--; and (C) in claim 30, on line 13, --said-- should be inserted after "coupling". Appropriate correction is required.

11. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed terminology which lacks such antecedent basis is as follows: (A) "said tip device is variably inclinable to an inclination", as now called for by claim 1; (B) "a leaf shaped spring", as now called for by claim 1; (C) "a . . . spring is provided at a backwards facing end portion of said tip device, for contacting an inner wall of said shaft", as now called for by claim 1; (D) "said tip device is variably inclinable", as now called for by claims 28, 30, 31 and 34. Correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-5, 8, 10-13, 16, 17, 19-21, 23-27 and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for the leaf spring being provided "for effecting a resetting force upon an increase of said inclination angle of said tip device or a return force, increasing when said control increases the pivot action of the tip device". However, the originally filed disclosure fails to support that the leaf spring effects such a resetting

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force or a return force. Hence claims 1-5, 8, 10-13, 16, 17, 19-21, 23-27 and 35 are directed to new matter.

14. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 29 calls for the tip device to be flattened “opposite to each of said guiding means”. However, the originally filed disclosure fails to support such a disposition. Hence claim 29 is directed to new matter.

Claim Rejections - 35 USC § 102

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. Claims 28 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Garvey. Garvey discloses a writing or inscribing instrument having all the claimed features including a sleeve-shaped shaft A, a main axis (note the axis formed by parts A, C and B in Fig. 1), a terminal part at a rear end of the shaft A (note the top end of shaft A in Fig. 1), a substantially conical tip device (constituted by lower member B as shown in Fig. 1) at a front end portion of the shaft A, the tip device being variably inclinable by being controlled by the pressure applied to the tip (note lines 45-48 on page 2) and tiltable or pivotable or inclinable (note lines 36-38 on page 2) in a pivot plane comprising the main axis and relative to the shaft A (note Fig. 5), and an inclination angle of a cone axis of the tip device B being adjustable in relation to the main axis (note Fig. 5 and lines 32-48 on page 2). With respect to claim 28, Garvey also discloses guiding means (constituted by the unslotted portions of member B) extending in a direction parallel to the pivot plane and being located at the

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front end of the shaft A at a distance from the main axis and on both sides thereof (note Fig. 5) for guiding the adjustment of the inclination angle.

17. Claims 28 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganter (German Patent '614). Ganter discloses a writing instrument having all the claimed features including a sleeve-shaped shaft b, a main axis (note the axis formed by shaft b), a terminal part at a rear end of the shaft b (constituted by the end of shaft b opposite to the writing tip a), a substantially conical tip device (constituted by the lower end of writing tip a) at a front end portion of the shaft b, the tip device being variably inclinable by being controlled by the joint c and the nut d and pivotable or inclinable in a pivot plane comprising the main axis and relative to the shaft b, and an inclination angle of a cone axis of the tip device a being adjustable in relation to the main axis. With regard to claim 28, Ganter also discloses guiding means (constituted by the nut d) extending in a direction parallel to the pivot plane and being located at the front end of the shaft b at a distance from the main axis and on both sides thereof (note Fig. 5) for guiding the adjustment of the inclination angle.

Claim Rejections - 35 USC § 103

18. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

19. Claims 31-33 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacou in view of Ducharme. Bacou discloses a writing instrument having the claimed features including a sleeve-shaped shaft or body 12, a main axis (note the axis formed by shaft 12), a terminal part at a rear end of the shaft 12 (constituted by the end adjacent the cover 13), a substantially conical tip device (constituted by the end of shaft 12 at writing tip 9) at a front end portion of the shaft 12, the tip device being variably inclinable by being controlled by the material forming junction 11 and

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pivotal or inclinable in a pivot plane comprising the main axis and relative to the shaft 12, and an inclination angle of a cone axis $x'-x$ (note Fig. 1) of the tip device being adjustable in relation to the main axis, and wherein the terminal part is received in the shaft end portion for permitting an opening of the writing instrument to exchange the refilling device 8. Although Bacou fails to disclose that the terminal end part is rotatably received in the shaft, attention is directed to Ducharme who discloses another writing instrument having a terminal end part constituted by cap 17 screw threadably, i.e., rotatably, received in the shaft 16. It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to substitute for the terminal end part of Bacou, the screw threaded terminal end part or cap as, for example, taught by Ducharme wherein so doing would amount to mere substitution of one terminal end cap for another that would work equally well in the Bacou device. With respect to claim 18, Ducharme further teaches the obviousness of restricting the rotation of the terminal end part by tightness and a circumferential "lock-in" position where the screw threads end. With respect to claim 32, Ducharme further teaches the obviousness of the terminal end part being received by means of thread elements (note lines 58-62 in col. 1). With regard to claim 33, Ducharme also teaches the obviousness of the terminal end part or cap having an inclined surface at a front portion thereof (note Fig. 2).

Allowable Subject Matter

20. Claims 30 and 22 are allowed.

Response to Arguments

21. Applicant's arguments filed September 8, 2003 (Paper No. 12) have been fully considered but they are not deemed persuasive.

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22. Contrary to applicant's arguments, new claim 28 does not incorporate the subject matter of original claim 7 which was previously indicated to be allowable.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580.

The Official FAX phone number for the organization where this application is assigned is: 703-872-9306. This FAX is located in Crystal Mall, Building 1, which is some distance away from the examiner's location in Crystal Park, Building 1. Hence, the examiner has no immediate access to faxes.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

December 8, 2003



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700